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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/697,542	08/27/1996	ROBERT S. BLOCK	003750-006	9969

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EXAMINER

SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/697,542

Applicant(s)

BLOCK, ROBERT S.

Examiner

Vivek Srivastava

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,31,34,45,47 and 61-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 31 is/are allowed.
- 6) ☒ Claim(s) 34,45 and 61-66 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicants argue, it is respectfully submitted that Hite fails to teach scheduling the presentation of an advertisement within a predetermined time interval of the content of the information as encompassed by claims 45 and 61.

The Examiner respectfully disagrees. Hite discloses "A context code could be appended to the commercial's CID code. The context code is compared with program identification codes appended to the program signals. The commercial is displayed if it is in a specific channel or network of show. For example, skiing equipment commercials would be shown during a skiing down hill racing competition" (see col. 4 lines 33-40). Hite further discloses that the advertisements are inserted during advertising breaks (see col 17 lines) and retrieving an advertisement intended for consumer viewing a display at a particular time (see col. 17 lines 31 – 33). It is noted when the occurrence of the content level occurs, the advertisement is displayed within a predetermined interval after the occurrence, or during a program, during an advertising break or during a particular time. As a result, Applicant's arguments are not persuasive.

Applicant's argue, "Independent claims 63 and 65 are also allowable. These claims recite a scheduling step wherein an advertisement is presented outside of predetermined time interval..." which is not disclosed by Hite.

The Examiner respectfully disagrees. The claim as recited does not define or for that matter provided any specifics as to what the predetermined time interval is.

Applicant's simply claim advertisement is scheduled for display outside a predetermined time interval after an occurrence of the instantaneous content level. The Examiner has equated the broadly recited "outside a predetermined time interval" as the predetermined processing time inherently present or required to display the advertisement after the occurrence of the instantaneous content level as the displaying the advertisement simply cannot take place instantaneously. In other words, there must be an inherent system delay or a minimum predetermined processing time interval before the advertisement can be displayed after the occurrence. This inherent interval meets the claimed predetermined processing interval since the claim fails to define or provide any specifics as to what the predetermined time interval is. It is further noted the scheduling would take place right after the occurrence. As a result, Applicant's arguments are not persuasive.

Applicants argue, it is respectfully submitted that Hite fails to disclose the feature of scheduling the presentation when the content is above a predetermined threshold value. Applicant further argues "Hite does not disclose content having a predetermined threshold value, which has a value, such as VS-0 to VS-7, as disclosed in Applicant's specification and recited in the claims."

The Examiner respectfully disagrees. Hite discloses "At the point of usage, a Commercial Processor (CP) is programmed to find and analyze the CID codes

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in each commercial. When a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer" (see col. 4 lines 3 – 8). Hite further discloses "A context code could be appended to the commercial's CID code. The context code is compared with program identification codes appended to the program signals" (see col. 4 lines 33 – 36). A advertisement is displayed when the value of the codes match. The threshold occurs when the codes match. When the codes are different, i.e. even a single code, the advertisement is not displayed. Thus a threshold for the number of codes must be met for the advertisement to be displayed. For example, if the context code contains 2 characters, in order for the commercial to be displayed, the context code would have to have both or 2 characters matching the program identification code. Thus the threshold would have to be greater than 1 character matching for the commercial to be displayed. It is noted that a code, as defined by Webster's Dictionary, comprises a plurality of characters (symbols, letters, numbers etc). Thus if a code has N characters, the threshold be N-1. Anything above a threshold of N-1 or N would permit displaying of the commercial. Thus Hite meets applicant's broadly claimed "above a predetermined threshold value". Regarding Applicants arguments to the Hite not disclosing a threshold value of VS-0 to VS-7, it is noted that the claim is void of the argued threshold value of VS-0 to VS-7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the threshold value of VS-0 to VS-7) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 45, 61, 63 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Hite et al (US 5,774,170).

Regarding claims 45 and 61, Hite discloses method and system for scheduling an advertisement during a program in relation the content of the program. Hite discloses comparing a commercial's context code with that of the program to ensure that a specific commercial is displayed during a specific program, i.e. a skiing

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commercial is displayed during a skiing program (see col 4 lines 33 – 44). It is noted that the selected commercial is displayed in the predetermined interval for the commercial slot when the commercial codes match or are above a 'predetermine threshold value'. The content having at least one aspect is inherently included, as it is used to match a commercial to a program in terms of context.

Regarding claims 63 and 65, Hite discloses method and system for scheduling an advertisement during a program in relation the content of the program. Hite discloses comparing a commercial's context code with that of the program to ensure that a specific commercial is displayed during a specific program, i.e. a skiing commercial is displayed during a skiing program (see col 4 lines 33 – 44) and thus the content level is scanned during the duration of the program to ensure all advertisements relating to the program are displayed during the program. It is noted that the selected commercial is displayed after the interval of determination. The broadly claimed 'outside a predetermined time interval' can be met by outside of the predetermined time interval for determining the context code of the program. The content having at least one aspect is inherently included, as it is used to match a commercial to a program in terms of context.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 62, 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al (US 5,774,170).

Claims 34 and 66 recites the same method for scanning, determining and scheduling as discussed above and is therefore not addressed here. Claim 66 further recites the program has an information label which rates the instantaneous content of the program at least two levels. Official Notice is taken it is well known to rate a program at two levels to provide a better more accurate means for determining the content of a program. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hite to include the claimed limitation to provide a better more accurate means for determining the content of a program.

Regarding claims 62 and 64, Hite fails to disclose the claimed wherein the instantaneous content comprises at least one category and a value for at least one category. Official Notice is taken it would have been well known to assign a category and value to a the category to provide a better more accurate means for determining the content of a program. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hite to include the claimed limitation to provider a better more accurate means for matching a commercial to a program with respect to content.

Allowable Subject Matter

Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27 and 31 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs
1/12/06



VIVEK SRIVASTAVA
PRIMARY EXAMINER